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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,817	10/19/2005	Karl-Heinz Schweikart	2003DE110	3993

25255 7590 04/14/2009

CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
4000 MONROE ROAD
CHARLOTTE, NC 28205

EXAMINER	
NILAND, PATRICK DENNIS	
ART UNIT	PAPER NUMBER
1796	

MAIL DATE	DELIVERY MODE
04/14/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/553,817	SCHWEIKART ET AL.	
	Examiner	Art Unit	
	Patrick D. Niland	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 January 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-10 and 12-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3-10, and 12-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. The amendment of 1/27/09 has been entered. Claims 1, 3-10, and 12-19 are pending.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the disclosed substituents, does not reasonably provide enablement for all of the substituents encompassed by the instant claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

A. The instant claim 3 recites "substituted" without specifying the substituents. Therefore the claims encompass all possible substituents. The instantly claimed "substituted" reads on an infinite number of compounds resulting from the potentially infinite number of substitutions which can be performed on the recited compounds. In re Wands has 8 criteria, (MPEP 2164.01(a)), as shown below.

(A)The breadth of the claims;

(B)The nature of the invention;

(C)The state of the prior art;

(D)The level of one of ordinary skill;

(E)The level of predictability in the art;

(F)The amount of direction provided by the inventor;

(G)The existence of working examples; and

(H)The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

It is noted that the instant claim reads on all potential substitutions of the recited compounds which encompasses an infinite number of compounds (Wands factor A). The specification does not describe how to make all such substituents, how to add them to the claimed compounds, nor how to select those substituents from the infinite list thereof which will function as required in the instant invention (Wands factors F, G). It would require an infinite amount of experimentation to determine how to make all of the substituents encompassed by the instant claims and another infinite amount of experimentation to determine which of these substituted compounds would function in the instantly claimed invention as required (Wands factor H). Chemistry is an unpredictable art (Wands factor E). The ordinary skilled artisan has not imagined nor figured out how to make all of the substitutions encompassed by the instant claim of "substituted" yet (Wands factors C, D, E, F, G, and H). The enabling disclosure is not commensurate with the full scope of the claimed "substituted".

See Sitrick v Dreamworks, LLC (Fed Cir, 2007-1174, 2/1/2008), particularly

"Before MICHEL, Chief Judge, RADER and MOORE, Circuit Judges.
MOORE, Circuit Judge.

112(1) Enablement - The enablement requirement is satisfied when one skilled in the art, after reading the specification, could practice the claimed invention without undue experimentation

> We review the grant of summary judgment de novo. LiebeI-Flarsheim Co. v. Medrad, Inc., 481 F.3d 1371, 1377 (Fed. Cir. 2007). Summary judgment is appropriate "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). Whether a claim satisfies the enablement requirement of 35 U.S.C. § 112, ¶ 1 is a question of law, reviewed de novo, based on underlying facts, which are reviewed for clear error. AK Steel Corp. v. Sollac, 344 F.3d 1234, 1238-39 (Fed. Cir. 2003). The evidentiary burden to show facts supporting a conclusion of invalidity is one of clear and convincing evidence because a patent is presumed valid. Id. The "enablement requirement is satisfied when one skilled in the art, after reading the specification, could practice the claimed invention without undue experimentation." Id. at 1244.
>
> **112(1) Enablement - The full scope of the claimed invention must be enabled. A patentee who chooses broad claim language must make sure the broad claims are fully enabled.**
>
> The full scope of the claimed invention must be enabled. See Auto. Techs. Int'l, Inc. v. BMW of N. Am., Inc., 501 F.3d 1274, 1285 (Fed. Cir. 2007). The rationale for this statutory requirement is straightforward. Enabling the full scope of each claim is "part of the quid pro quo of the patent bargain." AK Steel, 344 F.3d at 1244. A patentee who chooses broad claim language must make sure the broad claims are fully enabled. "The scope of the claims must be less than or equal to the scope of the enablement" to "ensure[] that the public knowledge is enriched by the patent specification to a degree at least commensurate with the scope of the claims." Nat'l Recovery Techs., Inc. v. Magnetic Separation Sys., Inc., 166 F.3d 1190, 1195-96 (Fed. Cir. 1999)."

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 3-10, and 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5938830 Kuo et al. in combination with WO 03/008510 as translated by US Pat. No. 7285592 Harz et al..

Kuo et al. discloses an aqueous colorant composition containing the instantly claimed amounts of the instantly claimed components A, B, and H but does not disclose the instantly claimed component C. See the abstract particularly noting "A variety of pigments, dispersants…"; column 1, lines 13-63, particularly 45-63; column 3, lines 5-67, particularly 24-67, which falls within the scope of the instantly claimed component B; column 4, lines 1-67, particularly 1-18, 25 et seq; column 5, lines 45-67, particularly 48-53, which is the amount of the instantly claimed component B; column 6, lines 1-67, particularly 20-25, 26-43, 44-46, which falls within the scope of the instantly claimed component E and its amount, lines 48-67, more particularly 48-50, which encompasses the instantly claimed component C, and 65-67, which falls within the scope of the amount of the instantly claimed component C; column 7, lines 1-67, particularly 1-15; column 8, lines 1-67, particularly 65 which shows the water to be deionized and to be used in the instantly claimed amounts as are the pigments; and the remainder of the document. It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed amount of component C in the compositions of Kuo et al. containing the instantly claimed amounts of the remaining components encompassed by Kuo and the instant claims and the amounts thereof because Kuo encompasses mixtures of dispersants in the sections discussed above and the ordinary skilled artisan would have expected the benefits of the combinations and amounts of surfactants of Kuo coupled with the benefits of the surfactants of Harz et al. in the final compositions. See Harz et al., abstract, which falls within the scope of the instantly claimed component C; column 1, lines 1-67; column 2, lines 1-12; column 3, lines 5-30; column 4, lines 7-21, 46-65; and the remainder of the document.

Alternatively, it would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed amount of component B in the compositions of Harz et al. containing the instantly claimed amounts of the remaining components encompassed by Harz and the instant claims and the amounts thereof because Harz encompasses mixtures of dispersants in the sections discussed above and the ordinary skilled artisan would have expected the benefits of the combinations and amounts of surfactants of Harz coupled with the benefits of the succinamates of Kuo et al. in the final compositions.

There is no probative evidence that any additional components of the prior art colorant dispersions are excluded by "consisting essentially of", particularly that they materially affect the basic and novel characteristics of the composition and that they are not encompassed by the broad language of the instant claims such as components F and G. The claims are therefore interpreted as encompassing any additional component that might be required of the prior art.

The instant claim 3 continues to encompass 0% since the claim does not otherwise modify the amount of claim 1.

It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the above discussed compositions in the form of the sets of the instant claims 12-17 because that is the commercially accepted means of supplying such inkjet inks of the cited prior art, as is well known and implied by Kuo, column 1, lines 16-19.

The applicant's argument that "consisting essentially" excludes the polyacrylates of Harz et al. because they might form insoluble complexes with some polyvalent metals is not probative evidence that the polyacrylates of Harz materially affect the basic and novel characteristics of the instantly claimed compositions. The prior art does not require the presence of the argued

polyvalent metals. There is no probative evidence that the polyacrylate alone materially affects the basic and novel characteristics of the compositions. The inkjet requirements and properties of column 1 of Harz appear to give inks that do not flocculate and that are storage stable. See column 1, lines 4-46, which states that there is no flocculation and no nozzle clogging in Harz. The argument that one would not use the instantly claimed component C of Harz alone is not persuasive since Kuo specifically teaches using this class of ingredient, i.e. dispersant, without polyacrylate at column 7, lines 15 et seq.

It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the above discussed compositions to coat articles of the instant claim 19 with the above discussed inks because it is well known to inkjet print such articles as taught at column 5, lines 53-55 of Harz and the above ink properties would have been expected of these printed articles.

There is no showing of unexpected results stemming from the use of the instantly claimed combinations of ingredients and amounts thereof in a manner commensurate in scope with the instant claims and the cited prior art.

The applicant's arguments have been fully considered but are not persuasive for the reasons stated above. This rejection is therefore maintained.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Friday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patrick D Niland/
Primary Examiner
Art Unit 1796